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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,625	10/22/2001	Stephen J. Hawkins	56937US002	1418
32692	7590	10/22/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			ZIRKER, DANIEL R	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	
			1771	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 8/24/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes that in independent claim 1 applicants describe their primer first ingredient as a "maleated thermoplastic elastomer" whereas in the article claim 12 they characterize it as a "maleated rubber". Although the scope of the two terms is believed to be substantially identical, it is suggested that applicants amend the claims so as to adapt a consistent terminology throughout the claims.

3. Claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Babu et al. taken in view of Hansen et al., substantially for reasons of record, particularly as set forth in paragraph No. 3 of the last Office action, Paper No. 051804, together with the following additional observations. To reiterate, Babu et al. discloses a genus of primers suitable for improving the adhesion of a pressure sensitive adhesive to a substrate such as a polymer film backing, the primer comprising a triblock copolymer of styrene-ethylene/butylene-styrene grafted with maleic anhydride mixed with an amorphous polypropylene. The reference lacks a teaching of the presence of a suitable "resin" such as a dehydrogenated hydrocarbon resin, but the secondary reference Hansen et al. discloses that end block compatible resins such as an aromatic resin are suitable for use in a

closely related primer composition having a functionalized elastomeric block copolymer as one of its components. Accordingly, one of ordinary skill, motivated by an expectation of improved elevated temperature bonding properties in primer compositions having a higher overall glass transition temperature would incorporate the resin of Hansen et al. into the primer compositions of Babu et al. and thereby clearly render obvious the claimed genus of primer compositions and accompanying articles. Applicants note (Response, page 7, second complete paragraph) that Hansen et al is explicitly directed towards resins that are compatible with the resinous (i.e., non-elastomeric) end block portion. Accordingly, applicants argue that Hansen et al teaches away from resins compatible with the elastomeric portions of a thermoplastic elastomer. However, the Examiner would like to modify an earlier statement, namely that he now believes that if an elastomer end block portion has its glass transition temperature raised, then the entire polymer would have its glass transition raised. As such, he must respectfully disagree with applicants who fail to recognize that raising the glass transition temperature of the end block portions would clearly have the effect of raising the glass transition temperature of the overall block copolymer, and thereby clearly render the claimed invention obvious, in the

absence of unexpected results not heretofore set forth on the record. In summary, the Examiner strongly disagrees with applicants' position (Response, page 7, third complete paragraph) that Hansen et al. teaches away from the desired claimed resins to be added to the composition of Babu et al.

4. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier

Serial No. 10/014,625

-5-

Art Unit 1771

communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

October 19, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300
1700

Daniel Zirker